

REMARKS

Claims 1, 3, 5-10, 12, 14-16, 18, 20-2, 24, and 26-36 are pending in this application. Claims 6, 7, and 9 are amended herein. Claims 31-36 are added herein. Support for the amendments to the claims may be found in the claims as originally filed. Support for the new claims may be found, inter alia at page 10 and in Figs. 5 and 6 of the specification. Further reconsideration is requested based on the foregoing amendment and the following remarks.

Interview Summary

The Applicants submit the following summary of the Office interview that took place October 27, 2005 between the undersigned representative of the Applicants and the Examiner.

Office Conference:

The Applicant thanks the Examiner for the many courtesies extended to the undersigned representative of the Applicant during the telephone interview that took place October 27, 2005.

Among the issues discussed during that interview were the patentability of the claims over the cited references.

Response to Arguments:

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive. The final Office Action, furthermore, does not even address the deficiencies of the references with respect to either "managing the URL and information as attributes of image data," or "managing the URL and information as attributes of the CAD parts data," which are discussed more fully below. Further reconsideration is thus requested.

Claim Rejections - 35 U.S.C. § 112:

Claims 6-9 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 6, 7, and 9 were amended to make them more definite. Withdrawal of the rejection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 102:

Claims 1, 10, 16, 22, 28 and 29 were rejected under 35 U.S.C. § 102(b) as anticipated by Johnson, *Bookmark Organizer Ready*, Electronic Engineering Times, July 31, 1995, pg. 140 (pgs. 1 and 2 as printed from ProQuest.) (hereinafter "Johnson"). The rejection is traversed.

Claims 1, 10, 16, 22, 28, and 29 recite,

"managing the URL and information as attributes of the image data."

Johnson neither teaches, discloses, nor suggests "managing the URL and information as attributes of the image data," as recited in claims 1, 10, 16, 22, 28 and 29. Johnson, rather, only discusses organizing web pages into user-defined hierarchical directories. Simply dragging and dropping a URL along with an image into a folder does not amount to "managing the URL and information as attributes of the image data," as recited in claims 1, 10, 16, 22, 28 and 29, contrary to the assertion at page 4 of the final Office Action.

Furthermore, in order for Johnson to serve as an anticipating reference, Johnson must enable that which it is asserted to anticipate. "A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003). See Bristol-Myers Squibb v. Ben Venue Laboratories, Inc., 246 F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001) ("To anticipate the reference must also enable one of skill in the art to make and use the claimed invention."); PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996) ("To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."). Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research, 68 USPQ2d 1373 (CA FC 2003):

Here, Johnson, at most, recounts a result produced by others, with no enabling details at all. Hence, Johnson cannot anticipate claims 1, 10, 16, 22, 28 and 29, regardless of what it recounts, since it does not enable claims 1, 10, 16, 22, 28 and 29. Claims 1, 10, 16, 22, 28 and 29 are submitted to be allowable. Withdrawal of the rejection of claims 1, 10, 16, 22, 28 and 29 is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 3, 5, 6, 12, 14, 15, 18, 20, 21, 24, 26, 27, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stierle, *BricsNet Acquires Leading Online Provider of Building Industry*, Business Wire, Oct. 26, 1999, page 1 (pgs 1-3 as printed from Pro Quest (hereinafter "Stierle") in view of Cunningham, *Built for Existing Users not the First-Timer*, Computing Canada, August 5, 1007, vol. 23, Iss. 16, pg. 28 (pages 1-3 as printed from ProQuest (hereinafter "Cunningham")). The rejection is traversed. Reconsideration is earnestly solicited.

The present invention (see claims 1, 3, 10, 12, 16, 18, 22, 24, 28, 29 and 30) is directed

to a system, process or medium by which an image (a CAD part) can be inserted into a users application (a CAD application). CAD parts have attributes, such as a path to a library containing the part, identification of a reference point for the part, etc. (see figure 6). When the part image is inserted into the application, the URL location for the image, or where it is published along with information about the image, such as the title of the page where the image is available, are used to update the attributes of the part in the CAD application. That is, the URL is made into an attribute of the CAD part and managed as an attribute. None of the cited references teach or suggest this.

Claims 3, 5, 6, 12, 14, 15, 18, 20, 21, 24, 26, 27, and 30, in particular, recite,
"managing the URL and information as attributes of the CAD parts data."

Neither Stierle nor Cunningham teach, disclose, or suggest "managing the URL and information as attributes of the CAD parts data," as recited in claims 3, 5, 6, 12, 14, 15, 18, 20, 21, 24, 26, 27, and 30. The final Office Action acknowledges graciously at page 8 that Stierle shows no "managing the URL and information as attributes of the CAD parts data," and asserts, incorrectly, that Cunningham can make up for this deficiency.

Cunningham, however, describes no "managing the URL and information as attributes of the CAD parts data" either, and thus cannot make up for this deficiency of Stierle. Posting a drawing on a web page so it may be viewed by others is not "managing the URL and information as attributes of the CAD parts data," contrary to the assertion in the final Office Action at page 8, even if a URL is attached.

The URL in Cunningham is not an attribute of CAD parts data, contrary to the assertion in the final Office Action, it is merely a URL associated with a drawing posted on the web. It may not even have anything to do with the drawing in DWF format, Cunningham since does not say. It may be a URL of the company's home page, where a viewer can go to learn more about the products available.

Furthermore, posting a drawing on the web is not CAD parts data, it is merely an image of something. There is no thought given in Cunningham to "managing the URL and information as attributes of the CAD parts data" at all. Thus, even if Stierle and Cunningham were combined, as proposed in the final Office Action, the claimed invention would not result.

Finally, the Office Action provides no motivation or suggestion to combine the teachings of Stierle and Cunningham, as required by 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D), beyond the assertion that,

"Cunningham discloses posting the CAD drawings in the Internet with their URLs providing the advantage to incorporate into Stierle for obtaining the CAD drawings with the URL of the web page in which the CAD data is published and easily managing the URL and information relating to the CAD data via inserting CAD drawings from the Internet along with their URLs and the specification, which is information related to the CAD data, via drag-and-drop operation to the client application."

Stierle, however, already *allows* specifications and CAD symbols to be inserted into designs. Stierle is complete in itself. Cunningham adds nothing to Stierle in that respect. The defect of Stierle, rather, as acknowledged by the final Office Action at page 8, is that Stierle shows no "managing the URL and information as attributes of the CAD parts data." It is submitted, therefore, that persons of ordinary skill in the art at the time the invention was made would have not been motivated to combine Stierle and Cunningham as proposed by the final Office Action because Stierle already allows specifications and CAD symbols to be inserted into designs. Neither the motivation nor the outcome described in the final Office Action adds anything to Stierle.

Finally, a reference must enable a claim in order to anticipate the claim, as discussed above. Here, neither Stierle nor Cunningham do anything more than recount a result produced by others, with no enabling details at all. Hence, neither Stierle nor Cunningham can render claims 3, 5, 6, 12, 14, 15, 18, 20, 21, 24, 26, 27, and 30 unpatentable, regardless of what they recount, since they do not enable claims 3, 5, 6, 12, 14, 15, 18, 20, 21, 24, 26, 27, and 30. Claims 3, 5, 6, 12, 14, 15, 18, 20, 21, 24, 26, 27, and 30 are thus also submitted to be allowable. Withdrawal of the rejection of claims 3, 5, 6, 12, 14, 15, 18, 20, 21, 24, 26, 27, and 30 is earnestly solicited.

Claim 7:

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stierle and Cunningham, and further in view of Puttre, *CAD Vendors Wrap Engineers in World Wide Web*, Design News, Feb. 17, 1997, vol. 52, Iss. 4, pg 58, (pages 1-5 as printed from ProQuest (hereinafter "Puttre")). The rejection is traversed. Reconsideration is earnestly solicited.

Claim 7 depends from claim 3 and adds further distinguishing elements. Neither Stierle nor Cunningham teach, disclose, or suggest "managing the URL and information as attributes of the CAD parts data," as discussed above with respect to the rejection of claim 3. Puttre does not either, and thus cannot make up for the deficiencies of either Stierle or Cunningham with respect to claim 7.

Puttre, rather, describes posting CAD images on the Internet. The flow of information in Puttre is, therefore, exactly opposite to that of the claimed invention. Puttre would thus have no interest in “managing the URL and information as attributes of the CAD parts data,” since the client is supposed to be posting CAD images to the Internet, not the other way around.

Furthermore, a reference must enable a claim in order to anticipate the claim, as discussed above. Here, neither Stierle, Cunningham nor Puttre do anything more than recount results produced by others, with no enabling details at all. Hence, neither Stierle, Cunningham nor Puttre can render claim 7 unpatentable, regardless of what they recount, since they do not enable claim 7. Claim 7 is thus also submitted to be allowable. Withdrawal of the rejection of claim 7 is earnestly solicited.

Claim 8:

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stierle and Cunningham, Puttre, and further in view of Smith, *Collaborate on the Web*, CADalyst, Feb. 1999, vol. 16, Iss. 2, pg 58, (pages 1-8 as printed from ProQuest (hereinafter “Smith”). The rejection is traversed. Reconsideration is earnestly solicited.

Claim 8 depends from claim 3 and adds further distinguishing elements. Neither Stierle, Cunningham nor Puttre teach, disclose, or suggest “managing the URL and information as attributes of the CAD parts data,” as discussed above with respect to the rejection of claim 3. Smith does not either, and thus cannot make up for the deficiencies of either Stierle, Cunningham or Puttre with respect to claim 8.

Smith, rather, describes a virtual work site where multiple users share and discuss designs, etc. All of the activity occurs on the virtual work site, with none occurring at the client. Smith would thus have no interest in “managing the URL and information as attributes of the CAD parts data,” since the client shouldn’t be doing anything where the other team members can’t see in any case.

Furthermore, a reference must enable a claim in order to anticipate the claim, as discussed above. Here, neither Stierle, Cunningham, Puttre, nor Smith do anything more than recount results produced by others, with no enabling details at all. Hence, neither Stierle, Cunningham, Puttre, nor Smith can render claim 8 unpatentable, regardless of what they recount, since they do not enable claim 8. Claim 8 is thus also submitted to be allowable. Withdrawal of the rejection of claim 8 is earnestly solicited.

Claim 9:

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Stierle and Cunningham, and further in view of Smith, *Collaborate on the Web*, CADalyst, Feb. 1999, vol. 16, Iss. 2, pg 58, (pages 1-8 as printed from ProQuest (hereinafter "Smith")). The rejection is traversed. Reconsideration is earnestly solicited.

Claim 9 depends from claim 3 and adds further distinguishing elements. Neither Stierle nor Cunningham teach, disclose, or suggest "managing the URL and information as attributes of the CAD parts data," as discussed above with respect to the rejection of claim 3. Smith does not either, and thus cannot make up for the deficiencies of either Stierle or Cunningham with respect to claim 9.

Furthermore, a reference must enable a claim in order to anticipate the claim, as discussed above. Here, neither Stierle, Cunningham, nor Smith do anything more than recount results produced by others, with no enabling details at all. Hence, neither Stierle, Cunningham, nor Smith can render claim 9 unpatentable, regardless of what they recount, since they do not enable claim 9. Claim 9 is thus also submitted to be allowable. Withdrawal of the rejection of claim 9 is earnestly solicited.

New Claims 31-36:

Claims 31-36 depend from claim 3 and add further distinguishing elements. None of the cited references teach, disclose, or suggest "managing the URL and information as attributes of the CAD parts data," as discussed above with respect to the rejection of claim 3. Claims 31-36 are thus believed to be allowable.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-36 are allowable over the cited references. If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 09/892,622

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 280005

By: 

Thomas E. McKiernan
Registration No. 37,889

1201 New York Ave, N.W., Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501